



Doc Code: AP.PRE.REQ

PTO/SB/33 (10-08)

Approved for use through 11/30/2008. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

2376.2142-001 (PA 09 0042)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on

11/20/08

Signature

Typed or printed name

Anne Amison

Application Number

10/722,230

Filed

November 25, 2003

First Named Inventor

Eugene F. Giszczynski

Art Unit

2419

Examiner

Bo Hui Alvin Zhu

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 61,287

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

Patrick A. Quinlan

Typed or printed name

978-341-0036

Telephone number

11/20/08

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒

*Total of one forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Eugene F. Giszczynski, James K. Thomas, Eric Peterson,
Dale A. Scholtens, and Michael J. Wurst

Application No.: 10/722,230

Group: 2419

Filed: November 25, 2003

Examiner: Bo Hui Alvin Zhu

Confirmation No: 6692

For: DISTRIBUTED VIRTUAL PATH

| | |
|---|--------------------|
| CERTIFICATE OF MAILING OR TRANSMISSION | |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or is being facsimile transmitted to the United States Patent and Trademark Office on: | |
| 11/20/08 | <i>Anne Amison</i> |
| Date | Signature |
| <i>Anne Amison</i> | |
| Typed or printed name of person signing certificate | |

REMARKS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is submitted in support of the Pre-Appeal Brief Request for Review, which is being filed in response to the Final Office Action mailed from the U.S. Patent and Trademark Office on July 22, 2008 (hereinafter "Final Office Action") in the above-identified application.

Claims 18-38 are pending in the application, of which Claims 18, 26, and 31 are independent. Claim 18 is recited below for convenience:

18. A method of monitoring a virtual path in a ring configuration comprising:
originating at least one of operations, administrative and
maintenance calls at a source network element on the virtual path; and
monitoring for the at least one of operations, administrative and
maintenance calls at the source network element on the virtual path.

Claims 18, 19, 21-26, 28-32, and 34-38 have been finally rejected under 35 U.S.C. 103(a) as being unpatentable over Huey *et al.* (U.S. Patent No. 5,467,349, hereinafter "Huey"). Claims 20,

27, and 33 have been finally rejected under 35 U.S.C. 103(a) as being unpatentable over Huey in view of Cappellari *et al.* (U.S. Patent No. 5,557,611, hereinafter "Cappellari").

Applicants respectfully submit that these rejections are clearly legally and factually deficient because 1) the combination proposed in the Final Office Action does not teach each and every element of the claimed invention and 2) the Final Office Action does not provide a proper motivation for the proposed combination.

1. A *prima facie* case of obviousness has not been established because the proposed combination does not teach each and every element of the claimed invention:

The Final Office Action cites col. 6, lines 32-38, as teaching the use of Operations, Administration, and Maintenance (OAM) calls, but the cited portion refers to policing traffic at the input ports of an ATM switch. The cited portion does not disclose the use of OAM calls; thus, Applicants respectfully submit that this reason, even by itself, renders the rejections legally and factually deficient. But further, the Final Office Action asserts that if Huey's Fig. 7, which shows a virtual path connecting three ATM switches, were arranged as in the configuration of Huey's Fig. 1, the resulting virtual path would begin at one ATM switch and end at that same ATM switch. But the virtual path of Fig. 7 begins at one ATM switch and ends at a different ATM switch, so, even if the switches of Fig. 7 were arranged as in Fig. 1, the virtual path would still begin at one switch and end at a different switch. As such, the resulting combination would not be able to originate an OAM call at one element and monitor for that same OAM call at that same element.

Therefore, not only does the proposed combination fail to disclose the use of OAM calls, but the proposed combination also fails to teach or suggest "*a virtual path in a ring configuration,*" "*originating ... calls at a source network element on the virtual path,*" and "*monitoring for the ... calls at the source network element on the virtual path,*" as claimed in independent Claim 18, and as similarly claimed in independent Claims 26 and 31. Applicants explained this difference in their response dated February 5, 2008.

Also, the Final Office Action asserts that the proposed combination of Huey's Figs. 1 and 7 results in three ATM switches that are in a ring configuration and that are connected by a single virtual path, thereby supposedly resulting in a virtual path that begins and ends at the same

ATM switch. This is still not the case, however, because the lines (ref. nos. 14) of Huey's Fig. 1, which connect the three ATM switches (ref. nos. 12), illustrate separate network-to-network interfaces (*see* Huey, col. 2, lines 26-27), and Huey does not state that the separate interfaces represent a single virtual path that begins and ends at the same switch. Even if it were assumed, *arguendo*, that all three lines (ref. nos. 14) were part of the same virtual path, Huey still does not disclose that the virtual path would begin and end at the same switch, or that an OAM call would be originated at one switch and that the same switch would specifically monitor for that same OAM call. As such, the proposed combination does not teach each and every element of the claimed invention.

2. *A prima facie* case of obviousness has not been established because the asserted motivation for the proposed combination is improper:

The Final Office Action states that one skilled in the art would be motivated to combine Huey's Figs. 1 and 7 because the combination would "eliminate the possibility of having a single point of failure in the network." This is not true. Arranging network elements in a ring configuration does not prevent a failure from occurring. It may help re-route traffic in the event of a failure, but it does not eliminate the possibility of a failure. Even if, *arguendo*, it would motivate one skilled in the art to arrange the switches of Fig. 7 in a ring configuration, it still does not provide any motivation to create a single virtual path that begins and ends at the same element.

Therefore, Applicants respectfully submit that the motivation suggested in the Final Office Action is not proper and would not lead one skilled in the art to create "*a virtual path in a ring configuration*" or to "*originat[e] ... calls at a source network element on the virtual path*" and "*monitor[] for the ... calls at the source network element on the virtual path,*" as claimed. As such, Applicants respectfully submit that the rejections are legally and factually deficient.

In view of the of the foregoing explanation of the deficiencies of the rejections,
Applicants respectfully request that the panel find all pending claims to be in condition for
allowance.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By 

Patrick A. Quinlan

Registration No. 61,287

Telephone: (978) 341-0036

Facsimile: (978) 341-0136

Concord, MA 01742-9133

Date:

11/20/08